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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/444,261 11/22/99 JACOFF

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EXAMINER

MMC2/0702

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ART UNIT

PAPER NUMBER

2859
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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/444,261

Applicant(s)

Jakoff

Examiner

Gail Verbitsky

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Mar 14, 2001

2a) ☐ This action is FINAL.

2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-45 is/are pending in the application

4a) Of the above, claim(s) 26-34 is/are withdrawn from consideration

5) ☐ Claim(s) is/are allowed.

6) ☒ Claim(s) 1-25 and 35-45 is/are rejected.

7) ☐ Claim(s) is/are objected to.

8) ☐ Claims are subject to restriction and/or election requirements

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2(4pgs)

20) ☐ Other:

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DETAILED ACTION

Restriction/ Election

1. The restriction requirement stated in the last Office Action (Paper No. 3) is hereby repeated, and thus made FINAL.
2. Applicant's election with traverse of the invention of Group I, claims 1-25 and 35-45, is acknowledged. Accordingly, claims 26-34, drawn to non-elected invention, are withdrawn from further consideration.
3. Invention of Group I is directed to a vial and requires a search in class 33, subclass 374 and 379, Invention of Group II is directed to a mold and requires the Examiner to search in class 425. Even though, Invention of Group II is directed to a mold for making a vial, these two Inventions acquired a different status in the art as shown by their different classification and, thus, require different search as shown above.

Claim Objections

4. Claim 3 is objected to because of the following informalities: Perhaps applicant should insert --opposed-- before "ends" in line 2. Appropriate correction is required.

Specification

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5. The specification is objected to because it appears that applicant uses reference character 57 to describe two different structures, the keys and the flanges. Perhaps applicant should replace "57" after "flanges" in page 12, last line with --65--. Correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 20-25 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In this case, it is not clear from the claims, specification and the drawings how the keys located adjacent to the open end can extend in opposite direction and to be adapted to be received in the opposite notches, because, according to the drawings, the opposite notches are located adjacent to opposite wall ends, wall end 9 and open end 6. Does applicant mean the direction along a vertical or horizontal axis? Do the notches extend from the open end 6 along the outer wall 3 to the wall end 9? Is this a proper interpretation of the invention? Same with the flanges claimed in claims 22-23.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 24-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In this case,

Claims 24-25: the claim language is confusing and contradicts to claim 13 because only one vial is being positively claimed in claim 13 which claims 23-24 are dependent on.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Johnson 3750301.

Johnson discloses in Figs. 1-3 a device comprising a straight cylindrical outer wall, an inner cavity A having a substantially uniform arc in a cross section, the arc having an apex 8 close to the cylindrical wall, opposite ends C spaced from the apex, opposed sides form a 90 degree angle at the apex. Planes D and E tangent to the sides are parallel to each other and form a 90 degree angle with a plane F tangent to the apex. At least one end of the cavity terminates in a wall. Johnson also discloses keys 14 extending from the outer wall in opposite direction along

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the length of the wall and being adjacent to both ends (the numerals A-F have been added by the Examiner, see attachment to the Office Action).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 2-6, 8 and 35-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson in view of Neis et al. [hereinafter Neis].

Johnson discloses the device as stated above in paragraph 11.

Johnson does not disclose the limitations of claims 2-6, 8 and 35-40.

Neis discloses in Fig. 4 a device in the field of applicant's endeavor comprising a vial 32 whose inner cavity is being curved with an apex A closer to an outer wall than to opposite ends (the numeral A has been added by the Examiner, see attachment to the Office Action).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the inner cavity in the device disclosed by Johnson, so as to have a curved inner cavity, as taught by Neis, because the shape of the cavity, i.e., curved, absent any criticality, is only considered to be an obvious modification of the shape of the cavity disclosed by Johnson because the courts have held that a change in shape or configuration, without

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criticality, is within the level of skill in the art as the particular shape claimed by applicant is nothing more than one of numerous shapes that a person having ordinary skill in the art will find obvious to provide for the inner cavity of the device disclosed by Johnson. In re Dailey, 149 USPQ 47 (CCPA 1976).

With respect to claims 35-40: the method steps will be met during the normal manufacturing of the device stated above.

14. Claims 7, 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson and Neis as applied to claims 2-6, 8, 35-40 above and further in view of Wullschleger 2752693.

Johnson and Neis disclose the device as stated above in paragraph 13.

They do not disclose the limitations of claim 7.

Wullschleger discloses in Fig. 1 a device having an open end covered with a disc (cap) 4.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device disclosed by Johnson and Neis so as to have an open end covered with a cap, as taught by Wullschleger, in order to be able to open/ close the end and to have an access to the inside of the cavity so as to inject liquid into the cavity.

With respect to claims 41-42: the method steps will be met during the normal manufacturing of the device stated above.

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15. Claims 13- 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hutchins et al. 5199177 [hereinafter Hutchins] in view of Johnson and Neis.

Hutchins discloses in Fig. 1 and abstract a device comprising a vial 30 positioned in a vial-receiving aperture in a web 24 having notches, the web is perpendicular to and connecting two opposed parallel surfaces (rails). Since the vial is positioned parallel to the rails, the plane tangent to its apex A will be parallel to the rails also.

Hutchins does not disclose all the limitations of claims 13-18.

Johnson discloses in Figs. 1-3 a device comprising a straight cylindrical outer wall 8, an inner cavity A having a substantially uniform arc in cross section, the arc having an apex B close to the cylindrical wall, opposite ends C spaced from the apex, opposed sides form 90 degree angle at the apex. Planes D and E tangent to the sides are parallel to each other and form a 90 degree angle with a plane F tangent to the apex. At least one end of the cavity terminates in a wall. Johnson also discloses keys 14 extending from the outer wall in opposite direction and being also adjacent to both ends.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace a vial disclosed by Hutchins with a vial, as taught by Johnson, because both of them are alternate types of vials which will perform the same function of determining level of a device being investigated, if one is replaced with the other.

Neis discloses in Fig. 4 a device in the field of applicant's endeavor comprising a vial

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32 whose inner cavity is being curved with an apex A closer to an outer wall than to opposite ends.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the inner cavity in the device disclosed by Hutchins and Johnson, so as to have a curved inner cavity, as taught by Neis, because the shape of the cavity, i.e., curved, absent any criticality, is only considered to be an obvious modification of the shape of the cavity disclosed by Johnson because the courts have held that a change in shape or configuration, without criticality, is within the level of skill in the art as the particular shape claimed by applicant is nothing more than one of numerous shapes that a person having ordinary skill in the art will find obvious to provide for the inner cavity of the device disclosed by Johnson. *In re Dailey*, 149 USPQ 47 (CCPA 1976).

16. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hutchins, Johnson and Neis as applied to claims 13-18 above, and further in view of Wullschleger.

Hutchins, Johnson and Neis disclose the device as stated above in paragraph 15.

They do not disclose the limitations of claim 19.

Wullschleger discloses in Fig. 1 a device having an open end covered with a disc (cap) 4.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device disclosed by Johnson and Neis so as to have an open

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end covered with a cap, as taught by Wullschleger, in order to be able to open/ close the end and to have an access to the inside of the cavity so as to inject liquid into the cavity.

Allowable Subject Matter

17. Claims 9-12, 43-45 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art cited in the PTO-892 and not mentioned above disclose related devices and methods.


19. It is not possible to apply the prior art of record to claims 20-25 due to the reasons stated above in paragraph 4.

20. Any inquiry concerning this communication should be directed to the Examiner Verbitsky whose telephone number is (703) 306-5473.

Any inquiry of general nature should be directed to the Group receptionist whose telephone number is (703) 308-0956.

GKV

June 14, 2001


ANDREW H. HIRSHFELD
PRIMARY EXAMINER